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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,000	04/26/2001	Frank Charles Pagano	Rev 98-25	7885

7590 11/03/2003

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New York, NY 10022

EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 11/03/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/843,000

Applicant(s)

PAGANO ET AL.

Examiner

Sharmila S. Gollamudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Receipt of Amendment C received on August 21, 2003 is acknowledged. Claims 1-19 and 21-36 are pending in this application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Rejection of claims 1, 3-10, 21-23, and new claims 31, 33 under 35

U.S.C. 102(b) as being anticipated by Perronin et al (3,991,007) is maintained.

Perronin discloses the preparation of pigmentary particles coated with an organic polymer. Perronin discusses the importance of pigments in many fields such as cosmetics. Note column 1, lines 10-12. Example 11 provides a composition with 100 parts a pigment, 350 parts heptane, 27 parts methyl methacrylate, and 12 parts acrylic acid.

*Note that the preamble "nail enamel composition" does not hold.

Response to Arguments

Applicant argues that the amended phrase "capable of forming a film on the nail" provides a structural limitation over the prior art and therefore Perronin does not anticipate the instant rejections.

Applicant's arguments have been fully considered but they are not persuasive. The examiner points out that the phrase "capable of forming a film on the nail" is an

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intended use and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In instant case, the Perronin's polymer is capable of forming a film.

In response to applicant's arguments, the recitation "a nail composition" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In instant case, the examiner points out that the inventive formulation of a solvent and polymer, does not recite any ingredients that differentiate it from the prior art. The prior art also clearly discloses a solvent, pigment, and polymer composition. Therefore, the instant claims are not distinguishable over the prior art merely due to the preamble. Clearly it can be seen from column 1, line 12, that Perronin's composition is also used in the cosmetic field.

Response to Arguments



Applicant's arguments with respect to claims 1-19 and 21-36 being unpatentable over Pagano et al have been considered but are moot in view of the new ground(s) of rejection.

Claims 1, 3-12, 14, 21-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Bednarek et al (6,254,878).

Bednarek et al disclose a nail polish composition containing acrylic polymers. The composition comprises a solvent system having no more than 30% water, 0.1-30% of a pigment, a film forming acrylic binder prepared from methacrylic monomer, and styrene and which further contains adhesion promoting monomers. See abstract. Example 1 discloses titanium dioxide or red iron oxide pigment (pigment), 0.1-15% bentonite clay (suspending agent), 3-10% dibutylphthalate plasticizer, butyl acetate solvent, and 40% acrylic polymer (20/70/10 wt. % butylmethacrylate-co-methacrylate-co-acrylic acid). Various polymers are taught with instant monomers are taught.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 13, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bednarek et al (6,254,878).

As set forth, Bednarek et al disclose a nail polish composition containing acrylic polymers. The composition can comprise water in the solvent system of no more than 30% water. See abstract. Instant plasticizers are taught as conventional additives for nail polish compositions on column 8, lines 51-65. Silicone copolymers are taught in the amount of 0.1-20%. See column 9. Bednarek teaches the use of non-acrylic binders such as cellulosic film formers (nitrocellulose) for gloss and hardness. See column 6, line 30.

Bednarek et al do not exemplify the instant plasticizer, a silicone glycol copolymer, or nitrocellulose.

It is deemed obvious to one of ordinary skill in the art at the time the invention was made to include the instant additives in the composition of Bednarek. One would be motivated to do so since Bednarek teaches the instant additives are suitable in the nail composition. Bednarek teaches the use of plasticizers in the art is conventional and many are known in the art. Therefore, one would be motivated to use the instant plasticizer with the expectation of similar results. One would be motivated to add nitrocellulose in the composition act as an auxiliary agent to increase gloss and hardness as taught by the reference. Therefore, with the guidance of the prior art it is deemed obvious to add the instant additives to yield the instant formulation.

Claims 17-19 and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bednarek et al (6,254,878) in view of Pagano et al (5,772,988).

As set forth, Bednarek et al disclose a nail polish composition containing acrylic polymers. Bednarek teaches that the nail composition matches the ability of nitrocellulose in its resistance to cracking, fading, chipping, and peeling. See column 1, lines 35-43.

Bednarek does not teach a kit.

Pagano et al disclose a nail composition containing butyl acetate, a copolymer with a polar monomer (acrylic acid) and a nonpolar ethylenically unsaturated monomer, pigments, a suspending agent (stearalkonium bentonite), silicone glycol copolymer, and a plasticizer (glyceryl tribenzoate) in instant amounts (Note examples). Monomer A (ethylenically unsaturated monomer) is in the amount of 30-95%, monomer B (acetoacetoxymoiety) in the amount of 5-50%, and monomer C (acrylic acid) in the amount of 1-20%. Note column 5, lines 24-29. Further, Pagano teaches an aqueous nail enamel composition (Note example 8). The kit contains the instant composition in container 1 with a cellulose polymer (nitrocellulose) and solvent in container 2. The cellulose film-former provides excellent wear characteristics and is applied as a basecoat and topcoat. The polymer composition is applied as the middle layer. See column 9.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Bednarek et al and Pagano et al and utilize a kit with a cellulose film-former. One would be motivated to do so since Pagano

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teaches the cellulose-film former improves the wear characteristics of the nail polish.

Further, Bednarek teaches the use of cellulose film-formers for the same function.

Therefore, one would be motivated to utilize a kit formulation with the expectation of similar results.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is (703) 305-2147. The examiner can normally be reached on M-F (7:30-4:30).

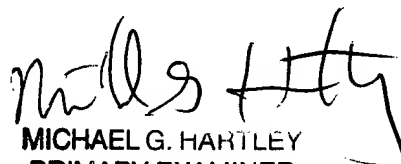
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SSG


10/20/03


MICHAEL G. HARTLEY
PRIMARY EXAMINER